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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/803,848	03/12/2001	Atsushi Ishihara	01136/LH	1282
1933	7590	07/15/2004	EXAMINER	
FRISHAUF, HOLTZ, GOODMAN & CHICK, PC 767 THIRD AVENUE 25TH FLOOR NEW YORK, NY 10017-2023			BAKER, CHARLOTTE M	
			ART UNIT	PAPER NUMBER
			2626	3

DATE MAILED: 07/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/803,848

Applicant(s)

ISHIHARA, ATSUSHI

Examiner

Charlotte M Baker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 2.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority under 35 U.S.C. 119(a)-(d). The certified copy has been filed in parent Application No. 2000-105147, filed on 04/06/2000.

### ***Information Disclosure Statement***

1. The information disclosure statement (IDS) submitted on 12/07/00 is being considered by the examiner.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-10 rejected under 35 U.S.C. 102(e) as being anticipated by Sato et al. (6,230,189).

### **Regarding Claim 1:**

- Sato et al. teaches an image output with a predetermined format (column 6, lines 30-33) and arriving with the address directed to itself (column 6, lines 1-16), which reads on “image outputting means provided in the facsimile terminal for outputting an image based on image data of a predetermined format arriving with the address directed to itself.”

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- Sato et al. teaches image data conversion (column 16, lines 35-42), which reads on “conversion requesting means provided in the facsimile terminal for transmitting the image data to the format converter when the image data format differs from the predetermined format, format converting means provided in the format converter for converting the format of the image data transferred from the facsimile terminal to the predetermined format.”
- Sato et al. teaches the process following data conversion (column 16, lines 35-44), which reads on “returning means provided in the format converter for transferring the image data after the format is converted by the format converting means to the facsimile terminal which has originally transferred the image data, the source of the image data, and image output controlling means provided in the facsimile terminal for allowing the image outputting means for outputting the image data transferred from the format converter as image data which has arrived with the address directed to itself.”

**Regarding Claim 2:**

- Sato et al. teaches an image output with a predetermined format (column 6, lines 30-33) and arriving with the address directed to itself (column 6, lines 1-16), which reads on “image outputting means for outputting an image based on image data of a predetermined format which has arrived with the address directed to itself.”
- Sato et al. teaches image data conversion (column 16 lines 35-42), which reads on “conversion requesting means for transferring the image data to the format converter

when the format of the image data which has arrived with the address directed to itself differs from the predetermined format.”

- Sato et al. teaches the process following data conversion (column 16, lines 42-44), which reads on “an image output controlling means that allows the image outputting means to output the image data transferred from the format converter as the image data which has arrived with the address directed to itself.”

**Regarding Claim 3:** Sato et al. teaches all limitations of claim 2. Sato et al. further teaches the Tagged Image File Format (TIFF) as a data format option (column 16, line 33), which reads on “the predetermined format is TIFF (Tagged Image File Format).”

**Regarding Claim 4:** Sato et al. teaches all limitations of claim 2. Sato et al. further teaches the data format conversion, and the generation of an email with the image data attachment (column 10, lines 46-50, 58-67 and column 11, lines 1-10 and column 17, lines 1-7), which reads on “the facsimile terminal, wherein the conversion requesting means transfers the image data to the format converter by sending out e-mail with the image data attached as the attached file.”

**Regarding Claim 5:** Sato et al. teaches all limitations of claim 4. Sato et al. further teaches a generated email with sender information (column 10, lines 66-67 and column 11, lines 1-3, Figure 2), which reads on “the conversion requesting means allows the e-mail with the image data attached as the attached file to contain the predetermined sender information for identifying the sender of the image data”.

**Regarding Claim 6:** Sato et al. teaches all limitations of claim 2. Sato et al. further teaches a method of storing sender information in memory (column 17, lines 35-52), which reads on “storage means for storing the predetermined sender information in memory for identifying the

sender of the transferred image data while the image data converted to the predetermined format is transferred from the format converter when the image data is transferred to the format converter.”

**Regarding Claim 7:** With respect to claim 7, arguments analogous to those presented for claim

mw **1** are applicable.

**Regarding Claim 8:** Sato et al. teaches all limitations of claim 7. Sato et al. further teaches TIFF as one possible predetermined format (column 16, line 33), which reads on “the predetermined format is TIFF (Tagged Image File Format).”

**Regarding Claim 9:** Sato et al. teaches all limitations of claim 7. Sato et al. further teaches a the process of sending the attached image file to the facsimile terminal following format conversion (column 8, lines 60-67, and column 9, lines 1-10), which reads on “transfers the image data to the facsimile terminal by sending out the e-mail with the image data attached as an attached file after the format has been converted.”

**Regarding Claim 10:** Sato et al. teaches all limitations of claim 9. With respect to claim 10, arguments analogous to those presented for claims 4 and 9 are applicable.

### ***Conclusion***

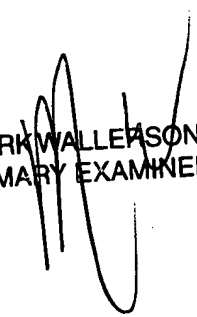
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Charlotte M Baker whose telephone number is (703) 306-3456. The examiner can normally be reached on Monday-Friday 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Kimberly A Williams can be reached on (703) 305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
cmb

  
MARK WALLER  
PRIMARY EXAMINER